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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,005	12/21/2001	Edward L. Boudreau	5892P001	2381

8791 7590 09/09/2003

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EXAMINER

KRECK, JOHN J

ART UNIT PAPER NUMBER

3673

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/028,005

Applicant(s)

BOUDREAU, EDWARD L.

Examiner

John Kreck

Art Unit

3673

-- Th MAILING DATE of this communication appears on th cover sheet with the correspondenc address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 23-29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-22 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election without traverse of claims 1-22 in Paper No. 9 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Furman, et al. (U.S. Patent number 6,260,621).

Furman teaches the method steps of adding an effective amount of a recovery composition comprising a fatty acid alkyl ester (col. 5, line 35), a surfactant (col. 6, line 30), and an acid (col. 6, line 57) to an oil reservoir; and removing oil as called for in claim 1.

Furman also teaches the adding via casing (col. 8, line 50) and waiting between 1 and 7 days as called for in claim 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furman, et al.

Furman fails to explicitly teach the 300 to 3000 gallons per well; and although Furman teaches the ester about 85 to 99.89 percent and the surfactant about .1 to 10 percent (see example 3), Furman fails to explicitly teach the concentration of acid. Furman does teach that the amounts of additives are variable, as known by those skilled in the art.

With regards to claim 2; it is noted that "mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148. It would have been obvious to one of ordinary skill in the art at the time of the invention to have practiced the Furman process with between 300 and 3000 gallons per well as called for in claim 2, based on design considerations.

With regards to claim 3; it would have been obvious to one of ordinary skill in the art at the time of the invention to have practiced the Furman process with about 0.01 to 5 percent acid, as called for in claim 3; based on design considerations.

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5. Claims 1, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyllie (U.S. Patent number 3,439,743) in view of Furman, et al.

Wyllie teaches a process including adding a composition to an oil reservoir.

Wyllie teaches a hydrocarbon solvent, not a composition including an ester, surfactant or colloid, and acid.

Furman teaches that a recovery composition comprising a fatty acid alkyl ester (col. 5, line 35), a surfactant (col. 6, line 30), and an acid (col. 6, line 57) is advantageous over hydrocarbon solvents, because the solvents produce hazardous vapors.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Wyllie process to have used a recovery composition comprising a fatty acid alkyl ester, a surfactant, and an acid as called for in claim 1, because the solvents produce hazardous vapors.

With regards to claims 7 and 8, Wyllie teaches the steam line and steam.

Allowable Subject Matter

6. Claims 9-22 are allowed.

7. Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Christopher, et al. (U.S. Patent number 3,817,330) teaches the

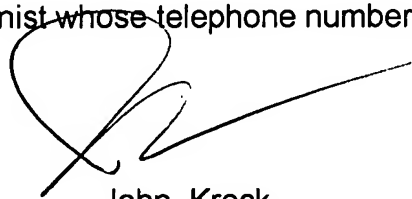
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use of a mixture of colloid and water as a driving fluid. Prats (U.S. Patent number 4,064,942) teaches steam treatment of a reservoir, with subsequent solvent treatment of the well. Woodhouse (U.S. Patent number 2,238,671); and Buckman, et al. (U.S. Patent number 3,354,033) teach well treatment with ester compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is (703)308-2725. The examiner can normally be reached on M-F 5:30 am - 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703)308-2978. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-4177.

A handwritten signature in black ink, appearing to be 'John Kreck', written over the printed name.

John Kreck
Examiner
Art Unit 3673

JJK